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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,757	07/17/2003	Collie Brown		1699

7590   05/31/2007

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EXAMINER
OBEID, MAMON A

ART UNIT	PAPER NUMBER
3609	

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05/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/621,757	BROWN, COLLIE
		Examiner	Art Unit
		Mamon Obeid	3609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07/17/2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1- 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All   b)☐ Some * c)☒ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This is in reply to application filed on 07/17/2003.

2.   Claims 1- 20 are presented for examination on the merits.

Priority

3.   Applicant's claim for the benefit of a U.S Provisional Application No. 60/396381, filed 07/17/2002 is acknowledged.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5.   Claims 1, 9 and 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.   Regarding claim 1, the phrase "*or any other relevant data*" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by " *or any other relevant data* "), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). For examination purposes, the examiner will interpret the term "*or any other relevant data" as* " or at least one relative data".

7.   Claim 9 recites the limitation "*Said vendors certificate verification*". There is insufficient antecedent basis for this limitation in the claim. For examining

purposes, the examiner will interpret the limitation "*Said vendors certificate verification*" as "said authenticity".

8.   The term "*may be*" in claim 19 is a relative term, which renders the claim indefinite. The term "*may be*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For examination purposes, the examiner will interpret the claim as "*wherein said certificate ~~may be~~ is used as an electronic rebate check*".

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1-11, 15-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitfield, U.S Patent No. 7,209, 889 B1.

11.   **Examiner's Note**: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

12.   **As per claim 1:** *A method for creating electronic gift certificates involving at least one computer, is created from electronically signing data representing a monetary value, an expiration date, the name of the recipient, serial number, currency type or any other relevant data using a public private key encryption algorithm.* (Whitfield utilizes the public private key pairs in authenticating gift certificates, (see at least column 6, lines 15-26 and column 7, lines 26-32 and Fig. 3).)

13.   **As per claim 2:** *wherein said encryption algorithm is based on the public key infrastructure (PKI) standard including such algorithms as RSA public key encryption from RSA Security Inc.* (Whitfield teaches and utilizes a public key infrastructure (See at least column 9, lines 35 –54).)

14.   **As per claim 3:** *wherein said data is sent to a reviewer as an electronic file or data stream or any other convenient means of packaging data, to be reviewed for accuracy after which said reviewer having determined the information to be accurate uses reviewers own private key, electronically sign said data.* (Certificate acquirer associate his private key with the issued certificate (see at least column 14, lines 10- 23), Certificate acquirer is prompted to preview the certificate before it's transmitted (see at least column 14, lines 24-35).)

15.   **As per claim 4:** *wherein said signed data is sent to the Issuer where said data is again reviewed for accuracy before said Issuer using his or her private key generates and electronically signs or encrypts each electronic gift certificates.* (Issuer can review parameters associated with a virtual certificate (see at least

column 12, lines 34-40), the issuer utilizes the public key as part of the certificate packet (see at least column 7, lines 24- 32).)

16.   **As per claim 5:** *wherein said reviewer or Issuer may include a person or computerized system.* (See at least Fig. 1)

17.   **As per claim 6:** *wherein said certificates are distributed to recipients by various means including as an attachment in an email, downloaded form a web server or downloaded from a web server using a link in an email to locate the certificate.* (See at least column 14, lines 36-42.)

18.   **As per claim 7:** *wherein said recipients present said certificates electronically to designated vendors as payment for goods or services.* (See at least column 5, lines 10-18.)

19.   **As per claim 8:** *where said vendors use the public key of said certificate Issuer, verifies the authenticity of said certificates before providing goods or service.* (See at least column 9, lines 2- 13.)

20.   **As per claim 9:** *wherein said vendors certificate verification includes checking the content and format of the decrypted output of said electronic gift certificate after decrypting it with the issuers public key.* (See at least column 9, lines 2- 13.)

21.   **As per claim 10:** *wherein certificates passing said verification is redeemed before being submitted to the certificate issuer for reimbursement.* (See at least column 9, lines 54-67 and column 10, lines 1-3.)

22.   **As per claim 11:** *wherein said issuer will reimburse said vendors only if said certificate passes verification using the Issuers public key.* (See at least column 9, lines 28-53.)

23.   **As per claim 15:** *wherein the public key of said Issuer is distributed by secure means including encrypting said public key with a password, to relevant parties including vendors or computer systems, thereby providing said parties the ability to verify electronic gift certificates issued by said Issuer.* (The examiner takes Official Notice that encrypting a public key (double encryption) with another key or password is old and well established in the business of e-commerce as a secure way of transmitting keys and passwords over the computer network.)

24.   **As per claim 16:** *wherein savings from any unredeemed or expired gift certificates are retained by the certificate issuer.* (See at least column 13, lines 19-37.)

25.   **As per claim 17:** *whereby the certificate issuer establishes sufficient credit with vendors where certificates will be redeemed to cover the cost of redeemed certificates before the vendors are reimbursed.* (See at least column 10, lines 12 –33.)

26.   **As per claim 18:** *wherein said certificate issuers and said reviewer may have their responsibilities combined thereby requiring the use of one set of public private key pair.* (See at least column 9, lines 35 –54.)

27.   **As per claim 20:** *wherein said certificate may include a password whereby software can be used to force the certificate recipient to enter said password before said certificate can be presented to any vendor for redemption.* (See at least column 8, lines 49 –56.)

Claim Rejections - 35 USC § 103

28.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

29.   Claims 12, 13, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield (US Patent No. 7,209, 889 B1) in view of Maruyama et al (US Patent No. 6990585 B2).

30.   **As per claim 12:** *wherein said issuer using the public key of said reviewer verify that the data was signed by said reviewer and has not been altered, before said issuer is allowed to generate any electronic gift certificates.*

(Whitfield teaches all the limitations of claim 4 above but failed to explicitly teach a detailed authentication process, however, Maruyama teaches a method to authenticate the content and the signature of documents using a public key (see at least column 3, lines 41-51);

Therefore it would have been obvious to one of ordinary skill in the art to combine the method of issuance and redemption of a gift certificate taught by Whitfield with the digital signature method taught by Maruyama to increase the transmission security (see at least in Maruyama column 1, lines 51- 60).)

31.   **As per claim 13:** *wherein said electronic gift certificates utilizes the world wide web consortium (W3C) organization electronic signature XML specification as one means of encapsulating the electronic gift certificate.*

(Whitfield teaches all the limitations of claim 1 above but failed to teach the (W3C) XML signature technique, however, Maruyama teaches the incorporation of the (W3C) XML signature technique for more transaction protection (see at least column 2, lines 5- 17);

Therefore it would have been obvious to one of ordinary skill in the art to combine the method of issuance and redemption of a gift certificate taught by Whitfield with the XML digital signature method taught by Maruyama to prevent data alteration and to acquire evidence to support transaction (see at least in Maruyama column 2, lines 5- 17).)

32.   **As per claim 14:** *wherein said XML specification is modified sufficiently to accommodate the additional data elements needed in an electronic gift certificate.*

(Whitfield teaches all the limitations of claim 1 above but failed to teach a XML digital signature specification, however, Maruyama teaches a method that utilizes XML digital signature specification as a form of exchanging data (see at least column2, lines 5-17);

Therefore it would have been obvious to one of ordinary skill in the art to combine the method of issuance and redemption of a gift certificate taught by Whitfield with the XML digital signature method taught by Maruyama to handle additional and complicated data more effectively (see at least in Maruyama column 2, lines 5- 12).)

33.   Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield (US Patent No. 7,209, 889 B1) in view of Van Dusen (US Patent No. 6,175,823 B1).

34. **As per claim 19:** *wherein said certificate may be used as an electronic rebate check.*

(Whitfield teaches all the limitation of claim 1 above but failed to teach the use of a gift certificate as an electronic rebate check. However, Van Dusen teaches an electronic gift certificate system that credits the gift amount to a personal account (see at least column 2, lines 6-15);

Therefore it would have been obvious to one of ordinary skill in the art to combine the method of issuance and redemption of a gift certificate taught by Whitfield with the electronic gift certificate system taught by Van Dusen to credit recipients with the gift amount to their personal account when gift certificates are lost or expired (see at least in Whitfield column 2, lines 46-49).)

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Dusen, U.S Patent No. (US 6594644 B1) discloses an electronic gift certificate system. Meyer et al. (U.S Patent No. 6,915,271) discloses a method and system for delivering and redeeming promotional incentives over the computer network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on Mon- Fri 7:30am-5:00PM est. alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Reagan can be reached on (571) 270- 1245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit 3609
Date: 5/17/2007

Signature:
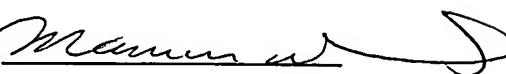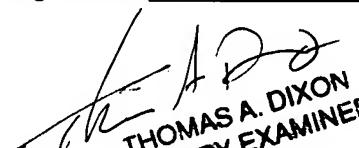
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